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In re Application of Richard G. Hyatt, Jr.
Appl. No.: 08/720,070
Filed: September 27, 1996
For: ELECTROMECHANICAL CYLINDER PLUG

**DECISION ON PETITION
UNDER 37 CFR 1.181**

This is a decision on the petition filed April 27, 2007 under 37 CFR 1.181 requesting entry of the amendment filed November 30, 2006 and for the examiner to reopen prosecution according to 37 CFR 41.39(b)(1). There is no fee required for this petition.

The petition is **DENIED**.

After review of the above file, the file history shows that a final Appeal Brief was filed on March 8, 2006 under the old Appeal Brief rules of practice 37 CFR 1.192. In response to this Appeal Brief, the examiner sent out an Examiner's Answer on September 27, 2006. Upon receipt of the Examiner's Answer, the applicant then filed the above-mentioned amendment on November 30, 2006 because it is alleged by applicant that the Examiner's Answer contains a new grounds of rejection as set forth by 37 CFR 41.39(a)(2). In response to the November 30, 2006 amendment, the examiner issued an advisory action February 27, 2007 indicating that the amendment would not be entered due to the fact that the Examiner's Answer clearly states that "no new grounds of rejection are presented (see footnote 1, page 4 of the Examiner's Answer)". The advisory action further stated that "the amendment will not be treated as a reply brief, since under 37 C.F.R. 41.44(b), a reply brief should not include any new amendment. Since this response includes an amendment, it is non-compliant under 41.44(b). Applicant's two month period for response (via reply brief) has expired and the file is being forwarded to the BPAI for docketing of appeal." It would like to be pointed out that the examiner has not indicated the correct section of the MPEP in the advisory action. The correct rule is not 41.44(b), but 41.41(a)(1) and (2) and 41.41(b).

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After reviewing appellant's amendment and arguments, the advisory action of February 27, 2007, and the Examiner's Answer of September 27, 2006 it has been determined that the indication in footnote 1 on page 4 of the answer is not a new grounds of rejection. This determination has been made because the examiner specifically stated that new grounds of rejection would not be presented at this time. Also, the statement is not located in the body of the office action under the statutes of double patenting. However, if the appellant does not agree with this logic, the appellant should then point their attention to the fact that the Appeal Brief was filed under the old appeal rules, i.e. 37 CFR 1.192. Under 37 CFR 1.193(a)(2) it is disclosed that no new grounds of rejection are allowed in an Examiner's Answer. Therefore, by rule, the examiner was prohibited from entering a new ground of rejection in the Examiner's Answer. Thus, the statement in footnote 1 on page 4 of the Examiner's Answer should not, and will not be considered as being part of the Examiner's Answer in light of this petition decision.

For the above reasons, it is believed that the statement in footnote 1 on page 4 of the Examiner's Answer is neither considered as being a new ground of rejection nor allowed to be in an Examiner's Answer. Therefore, the amendment filed on November 30, 2006 will not be entered, the applicant's request will not be entered and the application will not be reconsidered by the examiner under the provisions of 37 CFR 1.112, prosecution will not be reopened before the primary examiner in conformity with 37 CFR 41.39(b)(1), the examiner will not be directed to enter and consider applicant's amendment filed on November 30, 2006 pursuant to 37 CFR 41.39(b), and further relief as justice may require will not be granted to applicant.

Petitioner's request to have the amendment filed on November 30, 2006 entered and have prosecution reopened is **DENIED** for the reasons set forth above.

In conclusion, the application will be forwarded to the Board of Patent Appeals and Interferences so they may render their decision. However, if the appellant plans to file a renewed petition and would like that petition reviewed by a different party, the appellant should specifically ask for review of the TC Director's decision by the Director of the USPTO. Also, it is not believed that petitioner is owed any further relief at this time.

SUMMARY: The petition is **DENIED**.

Any questions regarding this decision should be directed to Supervisory Patent Examiner Brian Glessner at 571-272-6843.



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BG/SM: 7/25/07

